

ATTACHMENT A

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Counterclaimant Battens Plus, Inc.

IN THE UNITED STATES DISTRICT COURT
DISTRICT OF UTAH, CENTRAL DIVISION

DIVERSI-PLAST PRODUCTS, INC., a
Minnesota Corporation,

Plaintiff,

v.

BATTENS PLUS, INC., a California
Corporation,

Defendant.

AND RELATED COUNTERCLAIMS

Case No. 2:04CV01005 PGC

BATTENS PLUS, INC.'S FIRST
SUPPLEMENTAL RESPONSES TO
PLAINTIFF'S FIRST SET OF
INTERROGATORIES (NOS. 1 TO 10)

PROPOUNDING PARTY: Plaintiff Diversi-Plast Products, Inc.

RESPONDING PARTY: Defendant Battens Plus, Inc.

SET NUMBER: One

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Battens Plus further answers that the language of Claim 2 of the '193 Patent, the only claim alleged by Diversi-Plast to be infringed, is indefinite, as Diversi-Plast itself has admitted in a declaration supporting its Reissue Request. Because the language of Claim 2 is indefinite, there can be no infringement of that Claim. Moreover, Claim 1 of the '193 Patent, from which Claim 2 depends, includes "overlayment" and "tile" elements in addition to the "batten" element. Because Battens Plus does not manufacture or sell an "overlayment" or a "tile," Battens Plus does not directly infringe Claim 1 or 2 of the '193 Patent. Any assertion of contributory infringement or inducement of infringement is precluded by the fact that the BattenUp batten has substantial non-infringing uses, such as use with solar roofing panels, as shown in documents Bates labeled BP0929-0935.

INTERROGATORY NO. 7:

Identify and describe all facts, documents or other information that you contend constitutes prior art or which you contend renders any claims of the '193 Patent invalid, unenforceable or not infringed, including identification of any prior art that you contend the U.S. Patent and Trademark Office failed to consider that was more pertinent than the prior art of record, and a detailed explanation of how each such prior art reference is more relevant than the prior art of record.

RESPONSE TO INTERROGATORY NO. 7:

Battens Plus provided counsel for Diversi-Plast a complete Response to this Interrogatory on March 18, 2005, in the form of a Draft Request for Reexamination of the '193 Patent. The full text of that document is included herein by reference.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 7:

Battens Plus incorporates herein all previous objections to this request.

Subject to and without waiving any previous objections, Battens Plus further answers that in addition to each and every reference identified in the Request for Reexamination Under 35 U.S.C. § 302, a draft of which was sent to counsel for Diversi-Plast on March 18, 2005, the

following references also constitute prior art that individually or in combination render various claims of the '193 patent invalid, unenforceable and/or not infringed:

U.S. Patent No. 5,947,817;

U.S. Patent No. 5,094,041;

U.S. Patent No. 3,647,606;

U.S. Patent No. 5,471,807;

German Patent DE 44 21 941 A1 (produced with translation at DP02159-2174);

Each and every reference listed on the cover page of U.S. Patent No. 6,357,193 B1 starting at line 56;

Products and literature produced by Cor-A-Vent, Inc. as described in the Expert Report of Philip D. Dregger and attached thereto as Exhibit D; and

The work performed by Lars J. Walberg in 1997 relating to the invention of the '193 patent and prototypes, photographs, documents and communications relating thereto.

Battens Plus further states that the failure to name Lars J. Walberg as a co-inventor and/or disclose his work to the U.S. Patent and Trademark Office during prosecution of the '193 Patent constitutes inequitable conduct that renders the '193 Patent unenforceable.

Battens Plus incorporates herein by reference the Opening Expert Report of Philip D. Dregger Concerning U.S. Patent 6,357,193 B1 served on January 17, 2006 and the exhibits thereto.

INTERROGATORY NO. 9:

Identify and describe all facts and assertions underlying and supporting your contention that the '193 Patent is unenforceable due to any acts of alleged inequitable conduct.

RESPONSE TO INTERROGATORY NO. 9:

The applicant of the '193 Patent willfully failed to disclose to the United States Patent and Trademark Office at least the following prior art that directly relates to the patentability of the '193 Patent: United States Patent Nos. 5,469,795; 5,509,987; 5,617,690; 5,794,396; UK Patent Application No. GB 2,062,056 A; and German Patent No. DE 44 21 941 A1.

SUPPLEMENTAL RESPONSE TO INTERROGATORY NO. 9:

Battens Plus incorporates herein all previous objections to this request.

Subject to and without waiving its General Objections and all previous objections, Battens Plus further answers that Richard J. Morris committed fraud and inequitable conduct on the Patent Office on or around January 4, 2000. At that time, Morris declared to the Patent Office that he was the original, first, and sole inventor of the inventions claimed in the '193 Patent when, in fact, he was aware that another person, most likely Lars J. Walberg, actually conceived of the claimed inventions and was involved in experiments testing the claimed inventions. Morris again committed fraud and inequitable conduct on the Patent Office on or around June 28, 2004 when he declared to Patent Office that he was the original, first, and sole inventor of the inventions claimed in the '193 Patent. Evidence demonstrating Morris' fraud and inequitable conduct, and specifically Walberg's inventorship and Diversi-Plast's and Morris's knowledge of that inventorship prior to January 4, 2000, is found in the depositions of Richard J. Morris, Lars J. Walberg, and the 30(b)(6) deposition of Gary Urbanski and the exhibits to those depositions, specifically, without limitation, Exhibit 34.

All declarations from Morris, Walberg, and Diversi-Plast that assert Morris and Walberg are co-inventors, and all declarations claiming that any mistake as to inventorship was without deceptive intent, are also false and constitute fraud and inequitable conduct. Even assuming Diversi-Plast and Morris did have a good faith belief that Walberg's activity in 1997 did not constitute inventive acts, their failure to disclose Walberg's activity during prosecution constitutes a failure to disclose potentially invalidating prior art and is, in itself, fraud and inequitable conduct.

DATED: February 16, 2006

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By: 

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Battens Plus, Inc.

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